

REMARKS

Rejection Under Sec. 101

Claim 11 was rejected under 35 U.S.C. Sec. 101 because “the claimed invention is directed to non-statutory subject matter. The claims describe a method without being tangibly embodied (The medium of claim 11 could be a carrier wave signal which is non-statutory).

In response claim 11 has been amended to call for “a **tangible** computer readable medium....” Accordingly, applicant believes the section 101 rejection has been adequately addressed and that claim 11 is in condition for allowance.

Rejection Under Sec. 102

Claims 1-11 and 27-28 were rejected under 35 U.S.C. 102(e)¹ as being anticipated by U.S. Patent Application Publication No. 2002/0073204, inventor Dutta et al (“Dutta”).

35 U.S.C. 102(e) states:

A person shall be entitled to a patent unless -

(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or<

The applicant has carefully read the cited reference, paying special attention to the sections highlighted by the Office action and the applicant does not find some of the

¹(The statutory language quoted in the rejection is 102(e), but the actual rejection states “102(b).” The applicant assumes 102(e) is being used because the reference would not qualify as prior art under 102(b)

elements of the pending claims in Dutta. MPEP Sec. 2131 entitled "TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM" emphasizes the point that a reference must teach every element of the claim.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in "at least one of two-digit, three-digit, or four-digit" representations, was held anticipated by a system that offsets year dates in only two-digit formats). See also MPEP § 2131.02. "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

The applicant respectfully traverses the rejection of the claims as elements of the claims are not present in the prior art reference as highlighted below.

CLAIM 1

As to claim 1, the rejection states:

Dutta teaches a method of forming a peer-to-peer group, comprising the steps of selecting a friendly named for the group, calculating a category identification for the group, and providing the identification to a peer (Paragraphs 62-64).

The applicant has carefully read Dutta including paragraphs 62-64. There is no mention of the claimed "calculating a category identification (CID) for the group." Related, as the reference does not disclose "calculating a category identification (CID) for the group", it also does not disclose the claimed element of "providing the CID to a peer."

Perhaps the Office action contemplates a correlation between a CID and some other terms in paragraphs 62-64. However, all that has been provide to the applicant is what is quoted above which does not make such a correlation. Independently, the applicant attempted to make such a correlation but was unable as the concept of calculating and sharing a CID is not present in Dutta.

The applicant submits that claim elements are missing from paragraphs 62-64 of Dutta and that the Office action has failed to create a prima facie case of anticipation under 102(e). As such, the rejection of claim 1 has failed to create a prima facie case.

CLAIM 2

As to claim 2, the Office action states:

Dutta teaches a step of calculating a category ID by hashing (paragraph 67, Gnutella).

Similar to claim 1, the applicant does not find the teaching of calculating a category ID by hashing anywhere in the entire Dutta reference, let alone in paragraph 67 or in the discussion of Gnutella. A search for the term "hash" in Dutta does not return a single match. Hashing is a well known term and concept and there are few synonyms for hashing. The term and concept are not present in Dutta.

The applicant submits that claim elements are missing from paragraphs 67 of Dutta and that the Office action has failed to create a prima facie case of anticipation under 102(e). In addition, as claim 2 is dependent on claim 1 and elements of claim 1 are not present, the rejection fails for the same reasons as discussed under claim 1. Therefore, the rejection of claim 2 has failed to create a prima facie case.

CLAIM 3

As to claim 3, the Office action states:

Dutta teaches the method of claim 1 wherein the peer-to-peer group is to be private, wherein the step of providing the CID to a peer comprises the step of sending the CID to the peer out of band (paragraphs 62-64).

Similar to claim 1, the applicant does not find the teaching of sending the CID to the peer out of band anywhere in the entire Dutta reference, let alone in paragraphs 62-64.

A search for the term “band” in Dutta only brings up “bandwidth” which is used twice in a broad sense without discussing sending CIDs in or out of band or even acknowledging the concept of in or out of band. Again, the term and concept of in and out of band are not present in Dutta.

The applicant submits that claim elements are missing from paragraphs 62-64 of Dutta and that the Office action has failed to create a prima facie case of anticipation under 102(e). In addition, as claim 3 is dependent on claim 1 and elements of claim 1 are not present, the rejection fails for the same reasons as discussed under claim 1. Therefore, the rejection of claim 3 has failed to create a prima facie case.

CLAIM 4

As to claim 4, the Office action states:

Dutta teaches the method of claim 1, wherein the peer to peer group is to be public wherein the step of providing the CID to a peer comprises the step of registering the CID with a peer-to-peer name resolution protocol (PNRP) for discovery (paragraph 67, Gnutella).

The applicant does not find the teaching of providing the CID to a peer comprising the step of registering the CID with a peer-to-peer name resolution protocol (PNRP) for discovery in the entire Dutta reference, let alone in paragraph 67. A search for the term “register” in Dutta does not return any results. Paragraph 67 discusses function IDs and “Pong” messages, neither of which are comparable to registering with PNRP for discovery. Again, the term and concept of registering is not present in Dutta.

The applicant submits that claim elements are missing from paragraph 67 of Dutta and that the Office action has failed to create a prima facie case of anticipation under 102(e). In addition, as claim 4 is dependent on claim 1 and elements of claim 1 are not present, the rejection fails for the same reasons as discussed under claim 1. The rejection of claim 4 has failed to create a prima facie case.

CLAIM 5

As to claim 5, the Office action states:

Dutta teaches the method of claim 4, further comprising the steps of receiving connect messages from the peer and returning a welcome message to the peer (paragraphs 68-70).

Applicant agrees that paragraphs 68-70 of Dutta appear to disclose a pop-up box being displayed which may be similar to a welcome message. However, claim 5 also calls for "concatenating a peer ID with the CID to derive CID:ID, and registering CID:ID with PNRP for discovery therethrough." The concept of concatenating addresses is entirely absent from Dutta. In addition, as claim 5 is dependent on claim 4 and claim 4 is dependent of claim 1 and elements of claim 1 and 4 are not present in Dutta, meaning the rejection fails for the same reasons as discussed under claims 1 and 4. The rejection of claim 5 has failed to create a prima facie case.

CLAIM 6

As to claim 6, the Office action states:

Dutta teaches the method of claim 1 further comprising the steps of receiving connect messages from the peer and returning a welcome message to the peer (paragraph 67, Gnutella).

Applicant agrees that paragraph 67 of Dutta appears to disclose a pop-up box being displayed which may be similar to a welcome message. However, as claim 6 is dependent on claim 1 and elements of claim 1 are not present, the rejection fails for the same reasons as discussed under claim 1.

CLAIM 7

As to claim 7, the Office action states:

Dutta teaches the method of claim 6 further comprising the steps of calculating a signature of a group object database (paragraph 67, Gnutella).

The applicant does not find the teaching of calculating a signature of a group object database in the Dutta reference, let alone in paragraph 67. Paragraph 67 discusses Pong messages and function IDs, not calculating a signature of a group object database. Again, the term and concept of calculating a signature of a group is not present in Dutta.

The applicant submits that claim elements are missing from paragraph 67 of Dutta and that the Office action has failed to create a prima facie case of anticipation under 102(e). In addition, as claim 7 is dependent on claim 1 and elements of claim 1 are not present, the rejection fails for the same reasons as discussed under claim 1. The rejection of claim 7 has failed to create a prima facie case.

CLAIM 8

As to claim 8, the Office action states:

Dutta teaches the method of claim 7, including combining a unique ID with a sequence number and age (paragraph 67, Gnutella).

The applicant does not find the teaching of combining a unique ID with a sequence number and age in the Dutta reference, let alone in paragraph 67. Paragraph 67 discusses Pong messages and function IDs, not combining a unique ID with a sequence number and age. Again, the term and concept of combining a unique ID with a sequence number and age is not present in Dutta.

The applicant submits that claim elements are missing from paragraph 67 of Dutta and that the Office action has failed to create a prima facie case of anticipation under 102(e). In addition, as claim 8 is dependent on claim 7 and claim 7 is dependent on claim 1 and elements of claims 1 and 7 are not present, the rejection fails for the same reasons as discussed under claims 1 and 7. The rejection of claim 8 has failed to create a prima facie case.

CLAIM 9

As to claim 9, the Office action states:

Dutta teaches the method of claim 7, comprising the steps of receiving a request a specific group of objects (paragraph 67, Gnutella).

The applicant does not find the teaching of receiving a request for a specific group of objects in the Dutta reference, let alone in paragraph 67. Paragraph 67 discusses Pong messages and function IDs, not receiving a request a specific group of objects. Again, the term and concept of receiving a request a specific group of objects is not present in Dutta.

The applicant submits that claim elements are missing from paragraph 67 of Dutta and that the Office action has failed to create a prima facie case of anticipation under 102(e). In addition, as claim 9 is dependent on claim 7 and claim 7 is dependent on claim 1 and elements of claims 1 and 7 are not present, the rejection fails for the same reasons as discussed under claims 1 and 7. The rejection of claim 9 has failed to create a prima facie case.

CLAIM 10

As to claim 10, the Office action states:

Dutta teaches the method of claim 1 further comprising the steps of receiving a connect message from a peer and returning a refuse message to the peer along with a list of other members of the group (paragraph 67, Gnutella).

The applicant does not find the teaching of receiving a connect message from a peer and returning a refuse message to the peer along with a list of other members of the group in the Dutta reference, let alone in paragraph 67. Paragraph 67 discusses Pong messages and function IDs, not receiving a connect message from a peer and returning a refuse message to the peer along with a list of other members of the group. Again, the term and concept of receiving a connect message from a peer and returning a refuse message to the peer along with a list of other members of the group is not present in Dutta.

The applicant submits that claim elements are missing from paragraph 67 of Dutta and that the Office action has failed to create a prima facie case of anticipation under 102(e). In addition, as claim 10 is dependent on claim 1 and elements of claim 1 are not present, the rejection fails for the same reasons as discussed under claim 1. The rejection of claim 10 has failed to create a prima facie case.

CLAIM 11

As to claim 11, the Office action states:

Dutta teaches a computer readable medium.

Claim 23 of Dutta does call for a computer readable medium. However, pending claim 11 calls for the execution of the steps in claim 1 and as elements of claim 1 are

missing from Dutta as explained previously, the Office action has failed to create a prima facie case.

CLAIM 27

Claim 27 has been canceled.

CLAIM 28

Claim 28 has been canceled.

CONCLUSION

It is believed no fees are due with this response. If any fees are due, authorization is given to charge deposit account 13-2855. A duplicate copy of this paper is enclosed.

In view of the above amendments, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

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